

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/765,822

Filing Date: January 27, 2004

Appellant: Paul E. Krajewski

Group Art Unit: 1728

Examiner: John S. Maples

Title: EXTRUDED BIPOLAR PLATES

Attorney Docket: GP-303999

Mail Stop - Appeals
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APPELLANT'S REPLY BRIEF

This is Appellant's Reply Brief filed in response to the Examiner's Answer mailed June 02, 2011 to which a response is due by August 02, 2011. Please consider the comments below.

The Examiner asserts, on page 9 of the Examiner's Answer, that there is no inherent difference between the bipolar plates taught by Nishida and the bipolar plates claimed by Appellant. As discussed by Appellant on at least page 5 of the Appeal Brief filed March 16, 2011, the plates of Nishida are different because they have a clear stamped plate profile and because an extruded bipolar plate will have a different profile than a stamped bipolar plate. Examples of extruded bipolar plate profiles can be seen in Appellant's figures 2-9. It is the bipolar plates for fuel cells that are made by pressing and stamping manufacturing processes that Appellant is attempting to improve upon.

Furthermore, MPEP 2112 IV states, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (Emphasis in original). See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). MPEP 2112 IV also states that "[I]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Examiner asserts that there is no inherent difference between Appellant's bipolar plates and the plates of Nishida, however, the Examiner has not shown that Nishida inherently, i.e., necessarily, teaches an extruded bipolar plate for a fuel cell. Instead, Nishida explicitly states that the bipolar plates are stamped. Thus, Appellant respectfully maintains that Nishida does not anticipate Appellant's independent claims 1, 11 and 22.

The Examiner, on page 9 of the Examiner's Answer, states:

[T]his may be true that Nishida does not specifically teach a bipolar plate formed by extrusion, however, appellant has claimed a product and not a method of making that product. In a product-by-process claim, the method of making the product is immaterial. As long as the reference teaches the final product, then the claim is anticipated.

As discussed on at least page 6 of Appellant's Appeal Brief, the Examiner has agreed that the claimed bipolar plates are extruded bipolar plates and are structural elements. The Examiner has also acknowledged that both Nishida and Goebel do not teach extruded bipolar plates. Additionally, the *In re Thorpe* decision specifically addressed a claim for a product made by a process, i.e., a product-by-process claim. Appellant's independent claims are not product-by-process claims, thus, Appellant maintains that *In re Thorpe* does not apply.

The Examiner, on page 10 of the Examiner's Answer, maintains that Nishida has peaks and valleys, therefore, Appellant's claimed recesses are taught by Nishida. As

discussed on at least page 7 of Appellant's Appeal Brief, figure 1 of Nishida does not show recesses at each end of the plates. Additionally, nothing in the disclosure of Nishida discusses recesses at each end of the plates. The Examiner refers to reference numeral 37 of Nishida as teaching recesses, however, reference numeral 37 of Nishida is not an end plate. Thus, Appellant respectfully maintains that Appellant's claimed recesses are not taught by the prior art relied upon by the Examiner.

In view of the foregoing, it is respectfully requested that the Examiner's rejections be reversed.

Respectfully submitted,
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